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Serial No. 07/960,071  
Filed: October 13, 1992  
Page 3 (Amendment Under 37 C.F.R. §1.115 - January 30, 1995)

#### **REMARKS**

Reconsideration of this application is respectfully requested.

Claims 204-237 are pending in the application. Claims 236 and 237 have been amended above. No other claims have been amended, added or deleted by this Amendment. Accordingly, claims 204-237 are presented for further prosecution.

Applicants gratefully acknowledge the indication in the January 10, 1994 Office Action (page 2) that the restriction requirement has been withdrawn.

Applicants are submitting herewith attached as Exhibit 1 a Terminal (Statutory) Disclaimer and Certificate Under 37 C.F.R. §3.73(b) which have been signed by an officer duly authorized to act on behalf of the instant assignee, Enzo Diagnostics, Inc.

#### **The Rejection Under 35 U.S.C. §112, 2nd Paragraph**

Claims 230 and 236-237 stand rejected for alleged indefiniteness under 35 U.S.C. §112, second paragraph. In the Office Action (page 2), the Examiner stated that "[t]he recitation of 'oligo or polynucleotide is terminally ligated or attached to a polypeptide' in claim 230, lines 2-3 is indefinite because the meaning is not clear with regard to where to ligate or attach to a polypeptide. Claims 236-237 are vague and indefinite because both polydeoxyribonucleotide and polyribonucleotide are polynucleotide. One of ordinary skill in the art does not understand what polynucleotide is included in the claimed invention."

In response to the first issue regarding the terminal ligation or attachment of a oligo- or polynucleotide to a polypeptide [as recited in claim 230], Applicants respectfully would like to point out that such language is well recognized in the art and that the ordinarily skilled artisan would readily comprehend its meaning. Merely by way of example, Applicants note that similar claim language has already been issued in related United States Patent No. 5,241,060. See claim 26 of U.S. Patent No. 5,241,060, copy attached as Exhibit 2.

**Enz-5 (D5)(C)**

With respect to the second issue involving claims 236 and 237, Applicants have acceded to the Examiner's position by amending both claims above. As now amended, claims 236 and 237 recite "[t]he oligo- or polydeoxyribonucleotide" (in the case of claim 236) and "[t]he oligo- or polyribonucleotide" (in the case of claim 237). Claim 236 depends from claim 206 which is directed to an oligo- or polydeoxyribonucleotide; and claim 237 depends from claim 207 which is directed to an oligo- or polyribonucleotide. It is believed that the foregoing amendments serve to clarify the claimed subject matter and that both claims 236 and 237 now pass the statutory strictures for definiteness.

In light of the foregoing remarks and above amendments to the claims, Applicants respectfully request reconsideration and withdrawal of the rejection under §112, second paragraph.

**The Obviousness-type Double Patenting Rejection**

Claims 204-237 stand rejected under the "judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-24 of U.S. Patent No. 5,260,433. In the Office Action (pages 2-3), the Examiner stated that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the instant invention uses the same or similar concept and method of U.S. Patent No. 5,260,433 to label a signal attached to sugar moiety.

Thus, it would have been obvious to one of ordinary skill in the art to use the same or similar formula of U.S. Patent No. 5,260,433 for labeling a signal such as saccharide, antibody, radioactive isotope, enzyme, antigen and fluorescent component to obtain the result of expectation as suggested by the cited patent."

In response and in a sincere effort to advance prosecution, Applicants are submitting herewith attached as Exhibit 1 a Terminal (Statutory) Disclaimer and Certificate Under 37 C.F.R. §373(b) which have been signed by an officer duly authorized to act on behalf of the instant assignee, Enzo Diagnostics, Inc. In the Terminal (Statutory) Disclaimer (Exhibit 1), the instant assignee disclaims the terminal part of any patent granted on the subject application which would extend beyond November 9, 2010, i.e., the expiration date of U.S. Patent No. 5,260,433.

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In view of the submission of the Terminal (Statutory) Disclaimer (Exhibit 1), Applicants respectfully request reconsideration and withdrawal of the double patenting rejection, thereby placing each of claims 204-237 in allowable condition.

**Submission of Information Disclosure Statement**

Applicants' attorney and his assistant are presently assembling art-related documents for inclusion into an Information Disclosure Statement Under 37 C.F.R. §1.56 and 1.97-1.98. This IDS with documents will be submitted as soon as an indication has been received that the instant application has been revived.

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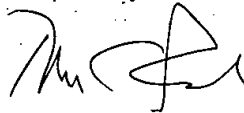
**SUMMARY AND CONCLUSIONS**

Claims 204-237 are presented for further examination. Claims 236 and 237 have been amended. No other claims have been changed, added or cancelled by this Amendment.

This Amendment is accompanying as Exhibit B a Petition to Revive An Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b) and authorization for the fee therefor. No fee is believed to be due for this Amendment itself. If any fee is due, however, for this Amendment, or other fee(s) are due for the Petition or Terminal (Statutory) Disclaimer (Exhibit 1), The Patent and Trademark Office is authorized to charge the amount of any such fee(s) to Deposit Account No. 05-1135, and to credit any overpayment thereto.

In view of the above discussion of the issues and amendments to the claims, and the submitted exhibits, Applicants respectfully submit that all of the instant claims are in allowable condition. Should it be deemed helpful or necessary, the Examiner is respectfully invited to telephone the undersigned at (212) 856-0876 to discuss the subject application.

Respectfully submitted,



Ronald C. Fedus  
Registration No. 32,567  
Attorney for Applicants

ENZO DIAGNOSTICS, INC.  
c/o Enzo Biochem, Inc.  
575 Fifth Avenue, 18th Floor  
New York, New York 10017  
Tel. (212) 856-0876]